

Ser. No. 09/939,211
Response and Amendment
Atty Docket 117163.00023

REMARKS/ARGUMENTS

Claims 1, 5, 6, 8-10, 12-18, 20, 44, 64, 67, 70, 71, 74-78, 81, 82, 85, 86, 89, 90, 94, 100 and 105-122 were pending at the time of the mailing of the outstanding Office Action. By this amendment, no claims have been cancelled, amended or added.

Claims 1, 5, 6, 8-10, 12-18, 20, 44, 64, 67, 70, 71, 74-77, 81, 82, 85, 86, 89, 90, 94, 100 and 105-122 stand rejected as being unpatentable over U.S. Patent 6,190,406 to Duerig et al. ("Duerig") in view of U.S. Pat. No 6,918,928 to Wolinsky et al. ("Wolinsky").

To establish a prima facie case of obviousness, three requirements must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. There must also be a reasonable expectation of success and the prior art reference or references must teach or suggest all of the claim limitations. (MPEP § 2143.) The Examiner maintains that Duerig discloses a plurality of annular support portions comprising bar elements and connecting bars, wherein the connecting bars engage a region of the first annular support portion that projects in the longitudinal direction and wherein the connecting bars engage a central portion of the second annular bar element portions. The Examiner acknowledges that Duerig does not teach a direction of curvature changing in the central region of the bar element when the stent is in the first position, but maintains that Wolinsky provides such a teaching to provide "the advantage of enabling the links 25 to fit together more closely in a nested arrangement with the undulation of rings 20a-c." However, Wolinsky teaches that it is the approximate equality of the portion of the rings that extends in the circumferential direction at the inflection point to the width of the link that provides the advantageous nested arrangement. (Column 6, lines 33-42.) It is not necessarily the inflection point curvature itself that provides this advantage, as maintained by the Examiner. Wolinsky also provides such an advantage for the embodiment illustrated in Fig. 2, which shows no inflection points (see column 5, line 53 – column 6, line 8). Additionally, there is no indication that Duerig does not provide a stent that adequately "nests" in the unexpanded state. In fact, observation of Figs. 2-4 of Duerig shows that

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the opposite is true. Therefore, there would be no motivation for one of skill in the art to combine the teachings of Duerig and Wolinsky, to provide a stent with an improved nesting arrangement in the unexpanded state as suggested by the Examiner.

One of ordinary skill in the art also would not find any other suggestion or motivation to combine the teachings of Duerig and those of Wolinsky in the remainder of those patents. Wolinsky indicates that the stent design disclosed therein addresses the need for longitudinal flexibility in a stent. There is no teaching or suggestion observed in Wolinsky for a stent that may be reversibly expanded *in situ* as disclosed in the present application (see paragraph 0016). While Wolinsky does disclose an arrangement to allow withdrawal of a stent into a guide catheter, this withdrawal is possible while the stent is still crimped onto a deployment balloon and therefore, the stent is still in an unexpanded state (Wolinsky, column 7, lines 40-45). Even in this situation however, the stent disclosed by Wolinsky is dissimilar to that of the present invention because Wolinsky solves the limited problem of withdrawing an undeployed stent into a guide catheter by adjusting the amplitude of rings 30a-c in Figs. 1 and 4 to prevent "flare" at the ends of the stent (column 7, lines 26-36), instead of altering the configuration of the bar elements and connecting bars such that a partially deployed stent may be withdrawn into a sheathing devise without hooking engagement between the stent and the sheathing device, as in the present invention. Additionally, Wolinsky is directed to an expandable stent that is designed to be used with a deployment balloon (see abstract, for example). Such a stent does not address self-expanding stents, as made possible by the present invention, and as recited in claims 12, 13, 67, 106, and 115.

Therefore, one of skill in the art would have had no motivation to combine the teachings of Duerig with those of Wolinsky to arrive at the present invention. Likewise, without a teaching or suggestion to provide such a stent as noted above, one of ordinary skill in the art would have had no expectation of success in combining the teachings of these references to provide a stent allowing for a partially deployed stent to be withdrawn into a sheathing devise without hooking engagement between the stent and the sheathing device. It is respectfully maintained that the current rejection of the claims is based on the use of impermissible hindsight to combine elements of the prior art to arrive at the

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present invention. Withdrawal of the rejection of the claims under 35 USC § 103(a) and the issuance of a Notice of Allowance is respectfully requested.

The outstanding Office action was mailed on 3 August 2005. The Examiner set a shortened statutory period for reply of 3 months from the mailing date. Therefore, a petition for an extension of time of one month is hereby made with this response. The Commissioner is authorized to charge any fee required with the filing of this response or to credit any overpayment to Deposit Account 15-0450.

Respectfully submitted,



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